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10/620,718

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Joseph L. Tallal JR.

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EXAMINER

RANGREJ, SHEETAL

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,718	<b>Applicant(s)</b> TALLAL, JOSEPH L.	
	<b>Examiner</b> SHEETAL R. RANGREJ	<b>Art Unit</b> 3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-9, 12-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9, 12-26, and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Prosecution History Summary***

- Claims 1, 10-11, and 27 are cancelled.
- Claims 2-9, 12-26 and 28-30 are pending.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/08/2010 has been entered.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 24, 3-6, 9, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Parker (U.S. Publication No. 2002/0184052).

3. As per claim 24, Parker teaches a method for providing a health care plan comprising the steps of

-receiving a membership fee from one or more individuals to become members of the health care plan (**Parker: para. 15**) and participate via incentives within a member multi-level marketing network, wherein one of the incentives includes paying a portion of each received membership fee into a multi-level marketing matrix (**Parker: claims 18-19; para. 16; 22-23**);

-obtaining information from one or more medical service/good providers that have joined the health care plan and incorporating all or part of the obtained information in a medical service/good provider listing stored on one or more storage devices communicably coupled to a server, wherein the medical service/good provider listing comprises basic listings and premium listings for the medical service/good providers (**Parker: para. 17-22**); and

-providing a discount price list stored on the one or more storage devices and the medical service/good provider listing to the members via a communications interface communicably coupled to the server, wherein the discount price list comprises published rates for the services/goods provided by each medical service/good provider within two or more geographic areas (**Parker: claim 1**) and each member can only access the published rates for the geographic area associated with the member (**Parker: claim 11**), and the discount price list regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the published rate on the discount price list for the services/goods rendered by the medical service/good provider in full directly to the medical service/good provider at the time the services/goods are rendered to the members by the medical service/provider thereby providing direct, immediate and full payment to the medical service provider without any review by the health care plan or a third party (**Parker: para. 16**).

4. As per claim 3, the method of claim 24 is as described. Parker further teaches wherein the membership fee is paid by the individual (**Parker: para. 15**).

5. As per claim 4, the method of claim 24 is as described. Parker further teaches wherein the membership fee is paid by the individual's employer (**Parker: para. 15**).

6. As per claim 5, the method of claim 24 is as described. Parker further teaches wherein the membership fee is paid by the individual's business (**Parker: para. 15**).

7. As per claim 6, the method of claim 24 is as described. Parker further teaches wherein the member ship fee is a renewal fee (**Parker: para. 15; i.e. annual fee**).

8. As per claim 9, the method of claim 24 is as described. Parker further teaches wherein the medical service/good provider is a doctor that works for a corporation (**Parker: para. 17**).

9. As per claim 13, the method of claim 24 is as described. Parker further teaches wherein the premium listings are available to medical service/good providers for a fee (**Parker: para. 15-17; claim 1**).

10. As per claim 17, the method of claim 24 is as described. Parker further teaches wherein the discount price and the medical service/good providers listing are accessible via a global telecommunications network (**Parker: para. 16-19**).

11. As per claim 18, the method of claim 24 is as described. Parker further teaches wherein the discount price list and the medical service/goods providers listing are searchable by the members using one or more search criteria (**Parker: para. 19-20**).

12. As per claim 19, the method of claim 18 is as described. Parker further teaches wherein one of the search criteria is based on geographic area (**Parker: claim 11**).

1. As per claim **25**, it is an article of manufacture claim which repeats the same limitations of claim **24**, the corresponding method claim, as a collection of executable instructions stored on machine readable media as opposed to a series of process steps. Since the teachings of **Parker** disclose the underlying process steps that constitute the method of claim **24**, it is respectfully submitted that they likewise disclose the executable instructions that perform the steps as well. As such, the limitations of claim **25**, are rejected for the same reasons given above for claim **24**.
2. As per claim **26**, they are apparatus claims which repeat the same limitations of claim **24**, the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of **Parker** disclose the underlying process steps that constitute the methods of claim **24**, it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claim **26** is rejected for the same reasons given above for claim **24**.
3. Claim 28 recite substantially similar limitations as those already addressed in claim 24, and, as such, are rejected for similar reasons as given above.
4. Claim 29 recites substantially similar limitations as those already addressed in claim 25, and, as such, are rejected for similar reasons as given above.
13. Claim 30 recites substantially similar limitations as those already addressed in claim 26, and, as such, are rejected for similar reasons as given above.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2 rejected under 35 U.S.C. 103(a) as being unpatentable over Parker (U.S. Publication No. 2002/0184052) in view of Wizig (U.S. Patent No. 6,735,569).

16. As per claim 2, the method of claim 24 is as described. Parker fails to expressly teach wherein the discount price list is a variable discount price list that tracks a known standard service/good price list.

Wizig, however, teaches wherein the discount price list is a variable discount price list that tracks a known standard service/good price list (**Wizig: col. 2, 60 to col. 3, 5**).

One of ordinary skill in the art would have recognized that applying the known technique of Wizig would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Wizig to the teachings of Parker would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such features into similar systems.

17. As per claim 7, the method of claim 24 is as described. Parker fails to expressly teach wherein the member can include his/her family in the health care plan.

Wizig, however teaches wherein the member can include his/her family in the health care plan (**Wizig: figure 12**).

The motivation to combine is the same as claim 2.

18. As per claim 8, the method of claim 24 is as described. Parker fails to expressly teach wherein the medical service/good providers are selected from the group consisting of physicians,

hospitals, physical therapists, nursing facilities, cancer treatment centers, optical and hearing aid dispensaries, hospices, clinics, pharmacies, chiropractors, dentists, medical supply stores, hospital supply stores, and handicap equipment suppliers.

Wizig, however, teaches wherein the medical service/good providers are selected from the group consisting of physicians, hospitals, physical therapists, nursing facilities, cancer treatment centers, optical and hearing aid dispensaries, hospices, clinics, pharmacies, chiropractors, dentists, medical supply stores, hospital supply stores, and handicap equipment suppliers (**Wizig: figure 27**).

The motivation to combine is the same as claim 2.

19. As per claim 12, the method of claim 24 is as described. Parker fails to expressly teach wherein the basic listings are free of charge to medical services/good providers.

Wizig, however, teaches wherein the basic listings are provided to medical service/good providers free of charge (**Wizig: abstract**).

The motivation to combine is the same as claim 2.

20. As per claim 14, the method of claim 24 is as described. Parker fails to expressly teach wherein the premium listings include a link to the medical service/good provider's web site, and wherein the premium listings are customized for each medical service/good provider.

Wizig, however, teaches wherein the premium listings include a link to the medical service/good provider's web site, and wherein the premium listings are customized for each medical service/good provider (**Wizig: col. 21, 36-50**).

The motivation to combine is the same as claim 2.



21. As per claim 15, the method of claim 24 is as described. Parker fails to expressly teach wherein the premium listings are hyperlinked to a medical service/good providers web site.

Wizig, however, teaches wherein the premium listings are hyperlinked to a medical service/good providers web site (**Wizig: col. 21, 36-50**).

The motivation to combine is the same as claim 2.

22. As per claim 16, the method of claim 24 is as described. Parker fails to expressly teach wherein the premium listings include a link to a customizable web page for the medical services/goods provider accessible via a global telecommunications network.

Wizig, however, teaches wherein the premium listings include a link to a customizable web page for the medical services/goods provider accessible via a global telecommunications network (**Wizig: col. 21, 36-50**).

The motivation to combine is the same as claim 2.

23. As per claim 20, the method of claim 18 is as described. Parker fails to expressly teach wherein one of the search criteria is based on the services provided by the medical service/good provider (**Parker: claim 11**).

Wizig, however, teaches wherein one of the search criteria is based on the services provided by the medical service/good provider (**Wizig: figures 34-38**).

The motivation to combine is the same as claim 2.

24. As per claim 21, the method of claim 24 is as described. Parker fails to expressly teach wherein the network provider provides the advertisements to members.

Wizig, however, teaches wherein the network provider provides the advertisements to members (**Wizig: col. 26, 22-38**).

The motivation to combine is the same as claim 2.

25. As per claim 22, the method of claim 21 is as described. Parker fails to expressly teach wherein the advertiser pays the network provider a fee for advertising (**Wizig: col. 26, 22-38**).

Wizig, however, teaches wherein an advertiser pays the network provider an advertising fee to provide the advertisements to the members (**Wizig: col. 26, 22-38**).

The motivation to combine is the same as claim 2.

26. As per claim 23, the method of claim 21 is as described. Parker fails to expressly teach wherein the advertisement is used to search the medical service/good provider listing.

Wizig, however, teaches wherein the advertisement is used to search the medical service/good provider listing (**Wizig: col. 26, 22-38**).

The motivation to combine is the same as claim 2.

### ***Response to Arguments***

27. Applicant's arguments with respect to claims 24, 2-9, 12-23, 25-26, and 28-30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. R. R./  
Examiner, Art Unit 3686

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